

REMARKS

Claims 1, 3 - 6 and 9 - 14 remain active in this application. Claims 7, 8 and 15 - 22 have been canceled, above in accordance with the previous cancellation of claim 2 and the previous election of species. Claim 1 has been amended to be specific to the previously elected species while remaining generic to the present requirement for election of species and to incorporate salient recitations of claim 7, now canceled. Claims 9 - 14 have been made dependent on claim 1 and editorially revised accordingly. Support for the amendments of the claims is found throughout the application, particularly in original claims and at page 4, lines 15 - 16. No new matter has been introduced into the application.

Although the previous requirement for election of species is not repeated in the present office action, it appears to have been adhered to in view of the continued holding of claims 8, 15 - 22 as withdrawn from consideration and the recital of the criterion thereof in the requirement for restriction. However, to expedite the prosecution, claims 8 and 15 - 22 drawn to the non-elected species have been canceled to render the issue moot. Nevertheless, clarification of the record in regard thereto is respectfully requested.

Restriction has been required between the inventions of Group I, claims 1 and 3 - 6, drawn to a polarizing filter including dielectric layers, and Group II, claims 7 and 9 - 14, drawn to a polarizing filter having at least three layers with the refractive index of odd-numbered layers being higher than a first index of refraction of an outermost layer. Provisional election of Group I has been made above, with traverse, particularly since the incorporation of criteria from the previous requirement for election of species is prejudicial and since a *prima facie* demonstration of

either distinctness or serious burden has not been made while claim 1 remained generic to the previously identified species and would be a linking claim under the present restriction requirement to the extent of that criterion. It is also respectfully called to the Examiner's attention that claim 1 has been amended to include some subject matter of claim 7, claim 7 has been canceled and claims 9 - 14 have been amended to depend from claim 1 to render the requirement moot. It is also respectfully submitted that the remaining claims clearly fall within the Examiner's recitation of the subject matter of the invention of Group I, notwithstanding these amendments, particularly since it continues to recite "dielectric" materials, a characteristic of the invention of Group I, as summarized by the Examiner. Further, to the extent that some recitations of claim 7 have now been added to claim 1, it is respectfully submitted that claim 1 is now a linking claim between the identified inventions and must be examined.

While the requirement for restriction is believed to be moot, the requirement is also respectfully traversed since no *prima facie* demonstration of serious burden in the absence of a requirement for restriction has been made. The Examiner has indicated that both identified inventions are classifiable in a common subclass but has not indicated any field of search required for one identified invention in which no prior art relevant to the other invention would be expected. See MPEP §808.02(C).

Further, it is respectfully submitted that the Examiner has not made a *prima facie* demonstration of the distinctness of the identified inventions since, while the Examiner is correct that subcombinations usable together may be shown to be distinct if they have separate utility, the Examiner's attempt to demonstrate separate utility is merely a restatement of

the asserted structural difference and does not, in fact, relate to any separate utility at all.

Therefore, no demonstration of distinctness of the identified inventions has been *prima facie* shown.

Accordingly, it is respectfully submitted that there is no basis for a requirement for restriction and that the requirement has been made in error, apparently largely for the purpose of buttressing (or restating) the prior requirement for election of species and possibly to attempt prevention of rejoinder upon allowance of a generic or linking claim. In any case, the requirement is now moot. Therefore, the foregoing is believed to be a full and complete response to the requirement for restriction. Favorable action on claims 1, 3 - 6 and 9 - 14 is respectfully requested.

The Examiner has further required election of species between species A and species B having outermost layers with different refractive indices. Provisional election of species B has been made above and claims 1, 3 - 6, 9 - 11, 13 and 14 have been designated as being readable thereon. At least claims 1, 3 - 6, 9 and 10 are generic to both species noted by the Examiner in the present requirement and, if found allowable, rejoinder of claim 12 must be permitted. Accordingly, favorable action on at least claims 1, 3 - 6 9 - 11, 13 and 14 is respectfully requested.

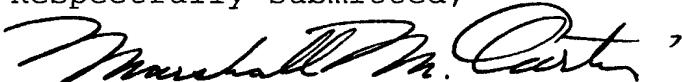
This requirement for election of species is also traversed for substantially the same reasons as set forth in the traverse of the previous requirement for election of species. Clearly, generic claims are present and should be allowable based on the fact that no prior art was applied to claim 7 in the previous office action and salient recitations of claim 7 have been added to claim 1 and a substantial traverse of the previous rejection of claim 1 has been presented. Only two claims are directed to the non-elected species and all claims in the application are commonly classified

and the species identified in this requirement would clearly require searches which are substantially congruent rather than divergent. Therefore, there can be no serious burden of examination in the absence of such a requirement. Accordingly, the requirement is without substantive justification and reconsideration and withdrawal thereof are respectfully requested.

Since all rejections, objections and requirements contained in the outstanding official action have been fully answered and shown to be in error and/or inapplicable to the present claims, it is respectfully submitted that reconsideration is now in order under the provisions of 37 C.F.R. §1.111(b) and such reconsideration is respectfully requested. Upon reconsideration, it is also respectfully submitted that this application is in condition for allowance and such action is therefore respectfully requested.

If an extension of time is required for this response to be considered as being timely filed, a conditional petition is hereby made for such extension of time. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-2041.

Respectfully submitted,



Marshall M. Curtis
Reg. No. 33,138

Whitham, Curtis & Christofferson, P. C.
11491 Sunset Hills Road, Suite 340
Reston, Virginia 20190

(703) 787-9400
Customer Number: 30743